

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of:	Juha KALLIO	Confirmation No.:	5666
Application No.:	10/517,442	Examiner:	Mehrpour, Naghmeh
Filed:	December 23, 2004	Group Art Unit:	2617

For: DOWNLOADABLE PROFILES FOR MOBILE TERMINALS

REPLY BRIEF

Commissioner for Patents
Alexandria, VA 22313-1450

Dear Sir:

This Reply Brief is submitted in response to the Examiner's Answer mailed August 4, 2009.

I. STATUS OF THE CLAIMS

Claims 28-58 are pending and are on appeal. Claims 1-27 have been previously canceled. Claims 28-52 and 54-58 remain rejected as anticipated under 35 U.S.C. §102(e) based on *Brescia et al.* (US 7,068,189) and claim 53 remains rejected as obvious under 35 U.S.C. §103 based on *Brescia et al.* (US 7,068,189) in view of *Murto et al.* (US 7,249,100).

II. GROUND OF REJECTION TO BE REVIEWED

Whether the subject matter of claims 28-52 and 54-58 is anticipated under 35 U.S.C. §102(e) based on *Brescia et al.* (US 7,068,189)?

Whether the subject matter of claim 53 is obvious under 35 U.S.C. §103 based on *Brescia et al.* (US 7,068,189) in view of *Murto et al.* (US 7,249,100)?

III. ARGUMENT

Appellant maintains and incorporate the positions presented in the Appeal Brief filed May 26, 2009, but presents further refutation of certain assertions presented in the Examiner's Answer.

Responsive to Appellant's argument that *Brescia et al.* do not disclose transmitting a profile to a mobile terminal, but, at best, only information derived from a profile is transmitted, the Examiner asserts, at pages 10-11 of the Answer, that the transmission of information defined by a profile is an inherent transmission of the profile itself. Appellant respectfully disagrees.

The *Brescia et al.* reference unambiguously states, at col. 4, lines 46-50, that "[e]ach profile will typically define information to provide to a select device when predefined event and location indicia are satisfied. The information provided to the user may be a simple notification, pre-selected content, or a combination thereof" (emphasis added). Thus, it is only certain information that will be provided. The information provided will be defined by the profile, but it is clearly not the profile that is transmitted to a mobile device in *Brescia et al.* Contrary to the Examiner's position, the transfer of information defined by a profile is, in no way, tantamount to the transfer of the profile itself. The Examiner's position is analogous to asserting that transmitting information from a database is equivalent to transferring the entire database to the device to which the information is transmitted. Those of ordinary skill in the art would recognize that merely transferring a piece of information from a database to another location is simply not the same as moving or copying an entire database to another location.

Appellant has defined a “profile” at page 1, lines 18-19, of the instant specification, for example, wherein it is stated that a profile constitutes “collections of user setting or preferences that the end user can automatically manage together.” Information defined by a profile, such as “a simple notification, pre-selected content, or a combination thereof,” as in *Brescia et al.*, are not “collections of user setting or preferences that the end user can automatically manage together” and cannot constitute the claimed “profile.”

Claim 28, for example, is explicit in “allocating a profile to a specific event” and, after “determining an association of the mobile terminal with said event,” and **“based on the determining” of profile reception capabilities of the mobile terminal**, “transmitting said profile to said mobile terminal.” Thus, the mobile terminal is determined to have profile reception capabilities, i.e., the mobile terminal is able to receive a profile, and it is the actual profile allocated to a specific event that is transmitted to the mobile terminal. This is in stark contrast to that disclosed by *Brescia et al.*, wherein **only certain information defined by a profile, but not the profile itself**, will be provided to a select device. Also, significantly, the information transmitted in *Brescia et al.* is not based on the capabilities of a mobile terminal to receive a profile, a feature specifically required by each of the claims on appeal. Moreover, again significantly, the instant claimed subject matter provides for customizing profiles based on on-going events. For example, claim 28 recites “allocating a profile to a specific event.” *Brescia et al.* provide for no such **profile**, which is **allocated to a specific event** and can be **transmitted to a mobile terminal based on determining of the profile capabilities of the mobile terminal**.

Information defined by a profile is not the same as the profile itself. To the extent the Examiner finds transmitting such information defined by a profile to be **“inherently transmitting the profile,”** as now contended in the Answer, the Examiner is challenged to produce some

evidentiary showing of the alleged “inherency.” That is, in order to establish inherency, the extrinsic evidence “must make clear that the missing descriptive matter is **necessarily present** in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.” *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) *citing Continental Can Co. v. Monsanto Co.*, 948 F.3d 1264, 1268, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991). Inherency, however, **may not be established by probabilities or possibilities**. Therefore, the Examiner must show that the transmission of information defined by a profile **must necessarily** include transmission of the profile itself. This, of course, the Examiner cannot do because transmission of information defined by a profile is **not** tantamount to the transmission of the profile itself.

For the reasons set forth in the principal Appeal Brief, and for the additional reasons above, the Examiner’s rejection of claims 28-52 and 54-58 under 35 U.S.C. §102(e) must be reversed and the Honorable Board is respectfully requested to do so.

Similarly, since *Murto et al.* do not provide for the deficiencies of *Brescia et al.*, noted above and in the principal brief, the rejection of claim 53 under 35 U.S.C. §103 must also be reversed and the Honorable Board is respectfully requested to do so.

V. CONCLUSION AND PRAYER FOR RELIEF

The claims require at least “allocating a profile to a specific event” and “transmitting said profile to said mobile terminal” but *Brescia et al.* fail to disclose these features. Appellant, therefore, requests the Honorable Board to reverse each of the Examiner’s rejections.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper,

including extension of time fees, to Deposit Account 504213 and please credit any excess fees to such deposit account.

Respectfully Submitted,

DITTHAVONG MORI & STEINER, P.C.

October 2, 2009

Date

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